

REMARKS

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-12 were originally presented for consideration in this application. Claims 13-20 were added by previous amendment. Accordingly, claims 1-20 are currently pending in this application.

The following rejections, objections, and requirements were set forth in the Office Action:

1. Claims 13-20 stand rejected as indefinite under 35 USC §112.
2. Claims 1-5 and 7-20 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 3,385,367 (Kollsman).
3. Claims 1-4, 7-9, 11-14, 16-18 and 20 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 7,066,284 (Wylie).
4. Claim 6 stands rejected under 35 USC §103(a) as being unpatentable over either of Kollsman or Wylie in view of U.S. Patent No. 6,102,119 to Raines.

Regarding the indefiniteness rejections of claims 13-20, please note that claim 13 recites "... the castable material partially displacing a fluid in the annulus, and the castable material being disposed radially between the expandable material and the borehole, but leaving at least one space containing the fluid in the annulus ..." as part of an overall step of flowing a castable material into the annulus. Applicants are entitled to set up a problem in a claim, as well as present a solution to the problem in the claim. A person skilled in the art would understand exactly what is recited in claim 13, and so the claim is not indefinite. Withdrawal of the indefiniteness rejections of claims 13-20 is respectfully requested.

Regarding the separate indefiniteness rejections of claims 17 and 18, these claims further define the limitations of the step of flowing the castable material into the annulus. There is nothing indefinite about these claims, and so withdrawal of the indefiniteness rejections of claims 17 and 18 is respectfully requested.

Regarding the anticipation rejections of independent claim 1 based on the Kollsman and Wylie references, please note that this claim has been amended above to recite that the castable material is disposed radially between and in contact with the borehole and the device, and that the expandable material extends from a retracted state to an expanded state independent of the tubular structure.

Neither of the Kollsman and Wylie references describes the combination of features now recited in independent claim 1. Therefore, withdrawal of the rejections of claim 1 and its dependents is respectfully requested.

Regarding the anticipation rejections of independent claim 8 based on the Kollsman and Wylie references, please note that this claim has been amended above to recite that the castable material providing step is performed after the tubular structure extending step, and that the expandable material is extended into contact with the wall of the borehole.

Neither of the Kollsman and Wylie references describes the combination of features now recited in independent claim 8. Therefore, withdrawal of the rejections of claim 8 and its dependents is respectfully requested.

Regarding the anticipation rejections of independent claim 13 based on the Kollsman and Wylie references, please note that this claim has been amended above to recite that the castable material flowing step is performed after the tubular structure installing step, and that the expanding step is performed in response to contact between the expandable material and the fluid.

Neither of the Kollsman and Wylie references describes the combination of features now recited in independent claim 13. Therefore, withdrawal of the rejections of claim 13 and its dependents is respectfully requested.

Regarding the obviousness rejections of claim 6, please note that this claim is allowable due to the allowability of its independent claim 1. In addition, a *prima facie* case of obviousness has not been made out since, as discussed above, all of the limitations are not described or suggested in the combinations of references proposed in the Office Action. Accordingly, withdrawal of the rejections of claim 6 is respectfully requested.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-20 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

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I hereby certify that this correspondence is being
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